REMARKS/ARGUMENTS

Claims 1-16, 18, 20 and 21 are pending in the application. By this amendment, claims 1, 14, 15 and 18 have been amended.

Applicants believe the amendments made herein add no new matter. Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based on prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to be attached thereto. Reconsideration and reexamination of the application is respectfully requested in view of the following remarks.

Related Applications

The present application is a continuation in part of U.S. Patent Application No. 10/250,095, filed June 3, 2003, which is currently under final rejection.

Interview Summary

The Applicants kindly thank the Examiners O'Connor and Nguyen for the telephonic interview with the Applicants' representatives on January 4, 2010. During the course of the interview it was suggested that further clarifying the range of indicia would be beneficial. No agreement was reached regarding patentability.

Rejections under 35 U.S.C. §101 and §112

Claims 14-16 have been rejected under 35 U.S.C. 101 for being directed to non-statutory subject matter and in particular, claim 14 has been rejected under 35 U.S.C. 112 for being a hybrid claim. The rejection is respectfully traversed.

Claims 14 and 15 have been amended to clarify that the claimed system is a product.   Applicants kindly request the withdrawal of the rejection.

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Rejections under 35 U.S.C. §103

Claims 1-6 and 14-21 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,931,387 to Wong et al. ("Wong") in view of U.S. Patent No. 3,788,695 to Salem ("Salem"). The rejection is respectfully traversed.

Wong discloses a method and system for facilitating resolution of engineering and business issues. The method comprises an issue component 102 for identifying issues to be resolved, an inquiry component 104 for facilitating collection of client information relevant to the issue component, a knowledge base 106 comprising data and information for facilitating assessment of the client information and a solution base 108 for compiling assessments and recommendations from the knowledge base and for reporting the assessments and recommendations to a client. The knowledge base 106 comprises an artificial intelligence (AI) engine for assessing the client information and comparing the client information with an existing issue in a database to determine if they are similar and if they are, providing a recommendation based on the existing issue. *Wong, Col. 7, ln. 16-23; Col. 11, ln. 60-64.* Wong discloses that the invention can be used in the ergonomic engineering industry. In the context of the ergonomic engineering industry, the AI engine can be used to provide recommendations relating to various categories of solutions such as product recommendations, administrative recommendations and engineering recommendations. *Wong, Col. 7, ln. 37-39.* Other information that can be provided includes a project summary of jobs analyzed and which jobs should seek ergonomic attention, a jobs list with a corresponding exposure risk index, injury cost projections and job tracking and reporting information. *Wong, Col. 11, ln. 20-27; Col. 13, ln. 36; Col. 13, ln. 43-35.*

Salem '695 discloses a therapeutic chair and table system for disabled individuals having a seat and tray table that are adjustable using a standard telescoping arm having multiple openings and a locking pin to lock the telescoping arm into position.

The Examiner has failed to establish a prima facie case of obviousness as required in any analysis under 35 U.S.C. §103 (A). To establish a *prima facie* case of obviousness, several basic criteria must be met. Under *Graham v. John Deere, 383 U.S. 1; 86 S. Ct. 684; 15 L. Ed. 2d 545 (1966),* it is necessary to 1) determine the scope and content of the prior art; 2) ascertain the differences between the prior art and the claims at issue; 3) resolve the level of ordinary skill in the pertinent art; and 4) evaluate evidence of

secondary consideration. Additionally, the obviousness evaluation will be informed by a showing of teaching, suggestion, or motivation that would lead a person of ordinary skill in the art to combine the prior art to meet the claimed subject matter, although a rigid application of this showing is not required. The obviousness analysis must be explicit, and it is necessary to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the prior art elements in the manner claimed. *KSR Int'l Co. v. Teleflex, Inc., 550 U.S. __; 127 S. Ct 1727; 82 U.S.P.Q.2d (BNA) 1385 (2007).*

The Examiner has failed to establish a *prima facie* case of obviousness because the Examiner has failed to properly ascertain the differences between the prior art and the claims at issue. In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) (original emphasis). *MPEP § 2141.02.*

In ascertaining the differences between the prior art and the claims at issue, the question is whether, prior to the claim of invention, the invention would have been obvious to a person of ordinary skill in the art as a whole (see *Schenck v. Nortron Corp.*, 713 F.2d 782, 784 (Fed. Cir. 1983)). Because the problem addressed by the Applicants and the Applicants' solution to the problem is unidentified in both Wong and Salem, Applicants' invention as a whole can not have been obvious to a person of ordinary skill in the art at the time of the invention. For this reason, the alleged combination of Wong and Salem is an improper combination, and one of ordinary skill in the art would not have combined the disclosures of Wong and Salem to reach the Applicant's invention without the benefit of hindsight.

Amended claim 1 calls for, in relevant part, a method for improving ergonomics for an individual comprising applying at least one indicium to the at least one item substantially along the range of motion for visually indicating a range of fit settings for the at least one physically adjustable parameter, wherein the at least one indicium is aligned with a plurality of the fit settings, adjusting the at least one physically adjustable parameter to at least one ergonomically correct fit setting indicated by the at least one indicium and storing data representative of the at least one ergonomically correct fit setting indicated by the at least one indicium associated with the particular individual. The at least one indicium has a first unique indicator generally associated with a portion of the range of motion adjacent the first end, a second unique indicator generally associated with a portion of the range of motion adjacent the second end, and at least

one intervening unique indicator between the first unique indicator and the second unique indicator, wherein the series of the first unique indicator, the second unique indicator and the at least one intervening unique indicator creates a visually-discernable unique indicator for each aligned fit setting along the range of motion.

Applicant's invention provides a method and a system for correlating an individual's calculated ergonomic fit settings with the adjustable aspects of the individual's workspace and providing a visual guide to the individual for adjusting the furniture and other items in the workspace. *Application as filed, ¶[0149]*. In addition, Applicant's invention addresses the need for a user-friendly system that provides safety and risk management teams the ability to audit and assure their employees are utilizing safe work habits, such as configuring their workspace to an optimal ergonomic fit. Employees often configure their workspace to their personal, subjective preferences, without regard to optimal ergonomics. *Application as filed, ¶[0011]*. As disclosed in the application, Applicant's solution to this problem is to determine an individual's fit setting for a particular piece of furniture based on an individual's response to survey topics that are input into functions to compute the calculated fit settings for various aspects of the furniture. *Application as filed, ¶[0146]*. The calculated fit settings are then correlated to a marking system, an example of which is illustrated in Figures 9 and 10.

As can be seen in Figure 9, the calculated fit settings are correlated to a marking system comprising a range of colors. The marking system comprises a corresponding color label 58 that can be applied to an adjustable area of a workspace, illustrated in Figure 10, in which a single color corresponds to a range of fit settings, each color being sub-graduated to differentiate between individual fit settings.

Figure 9 - Partial

Figure 10

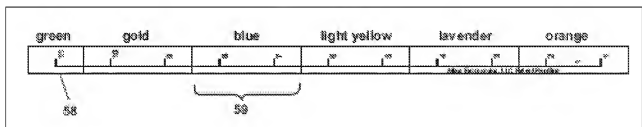Neither Wong nor Salem recognize the problem the Applicant is trying to solve nor the Applicant's solution as set forth in amended claim 1. As discussed above, Wong discloses an AI engine for correlating a client's input data with existing case data and determining a solution for the client's input data based on the existing case data the input data most closely resembles. Wong discloses that the

solution can be in the form of product recommendations, but provides no more details on the solution. *Wong, Col. 7, ln. 37-40.* Wong does not recognize the need for correlating an individual's calculated ergonomic fit settings with the adjustable aspects of the individual's workspace and providing a visual guide, nor the need for a user-friendly safety and risk management audit system, as Applicant does. Nor does Wong disclose Applicant's solution comprising applying at least one indicium to the at least one item substantially along the range of motion for visually indicating a range of fit settings for the at least one physically adjustable parameter, wherein the at least one indicium is aligned with a plurality of the fit settings, adjusting the at least one physically adjustable parameter to at least one ergonomically correct fit setting indicated by the at least one indicium and storing data representative of the at least one ergonomically correct fit setting indicated by the at least one indicium associated with the particular individual, as set forth in amended claim 1.

Salem discloses nothing more than an adjustable piece of furniture, which Applicant already discloses. *Application as filed, ¶[0011].* Salem does not recognize the problem Applicant is trying to solve nor Applicant's proposed solution.

In ascertaining the differences between the prior art and the claims at issue, the question is whether, prior to the claim of invention, the invention would have been obvious to a person of ordinary skill in the art as a whole (see *Schenck v. Nortron Corp., 713 F.2d 782, 784 (Fed. Cir. 1983)*). Because the problems addressed by the Applicant and the Applicant's solution to the problems are unidentified in both Wong and Salem, Applicant's invention as a whole can not have been obvious to a person of ordinary skill in the art at the time of the invention. For this reason, the alleged combination of Wong and Salem is an improper combination, and one of ordinary skill in the art would not have combined the disclosures of Wong and Salem to reach the Applicant's invention without the benefit of hindsight.

Even if the combination could be made, however untenably, the combination would still not reach Applicant's invention. As discussed above, Wong discloses an AI engine for generating solutions, an example of which can include a product recommendation. Neither Wong nor Salem disclose applying at least one indicium to the at least one item substantially along the range of motion for visually indicating a range of fit settings for the at least one physically adjustable parameter, adjusting the at least one physically adjustable parameter to at least one ergonomically correct fit setting indicated by the at least one indicium and storing data representative of the at least one ergonomically correct fit setting

indicated by the at least one indicium associated with the particular individual, as set forth in amended claim 1. Neither Wong nor Salem disclose <u>any</u> of these elements of amended claim 1.

The Examiner admits that Wong does not disclose applying at least one indicium to the at least one item. *Office Action, p. 4.* The Examiner cites Salem as disclosing the at least one indicium, however, Salem discloses nothing more than a piece of furniture having portions adjustable using traditional telescoping arms having a series of holes through which a locking pin passes through to lock the arm in place. At best, the telescoping arms of Salem correspond to the "physically adjustable" element of amended claim 1.

Assuming *arguendo* that the series of holes in Salem could be considered a form of indicia, the combination of Wong and Salem would still not reach Applicant's invention as set forth in amended claim 1. The applying of indicium, adjusting of a physical parameter and the storing elements of amended claim 1 relate to *fit settings* for an individual. The term "fit settings" is clearly defined in the application. As discussed in the application, an individuals fit settings are calculated based on an individual's responses to survey topics that are input into functions to compute the calculated settings for various adjustable aspects of the individual's furniture. The functions are developed from ergonomic engineering research. *Application as filed, § [0146].* Exemplary functions for determining an individuals fit settings are illustrated in Figure 8 of the Application. Neither Wong nor Salem disclose applying at least one indicium to the at least one item substantially along the range of motion for visually indicating a range of *fit settings* for the at least one physically adjustable parameter. Nor does Wong or Salem disclose adjusting the at least one physically adjustable parameter of the at least one item to at least one ergonomically correct *fit setting* within the range of *fit settings* indicated by the at least one indicium that locates the at least one physically adjustable parameter in a desired position for a particular individual. Nor does Wong or Salem disclose storing, in a medium readable by at least one of a machine and a user, data representative of the at least one ergonomically correct *fit setting* indicated by the at least one indicium associated with the particular individual. Neither Wong nor Salem disclose any of these elements of amended claim 1.

Because the Examiner has not established a prima facie case for combining Wong and Salem, the combination of Wong and Salem is improper and the rejection must fail. Therefore, for the reasons set forth above, amended claim 1 and dependent claims 2-13 are not obvious in view of Wong in

combination with Salem. Amended claim 1 and dependent claims 2-13 are therefore patentable over the combination of Wong and Salem.

The rejection of independent claim 14 relies on the same combination of references as the rejection of amended claim 1 discussed above. For the sake of brevity, Applicants will not repeat the arguments made above but incorporate these arguments herein by reference with respect to this rejection as to the uncombinability of these references with respect to amended claim 14. The Examiner has not made a prima facie case of obviousness under 35 U.S.C. §103 (A) under the Graham criteria as set forth above with the alleged combination of Wong and Salem for all the reasons set forth above. Therefore, amended claim 14 is patentable over Wong and Salem.

Claims 15 and 16, which depend from amended claim 14, are patentable for at least the same reasons as amended claim 14.

The rejection of independent claim 18 relies on the same combination of references as the rejection of amended claim 1 discussed above. For the sake of brevity, Applicants will not repeat the arguments made above but incorporate these arguments herein by reference with respect to this rejection as to the uncombinability of these references with respect to amended claim 18. The Examiner has not made a prima facie case of obviousness under 35 U.S.C. §103 (A) under the Graham criteria as set forth above with the alleged combination of Wong and Salem for all the reasons set forth above. Therefore, amended claim 18 is patentable over Wong and Salem.

Claims 20 and 21, which depend from amended claim 18, are patentable for at least the same reasons as amended claim 18.

Claims 7-13 are rejected under 35 U.S.C. 103(A) as being unpatentable over U.S. Patent No. 6,931,387 to Wong et al. in view of U.S. Patent No. 3,788,695 to Salem and further in view of U.S. Patent No. 5,918,693 Mantovani. The rejection is respectfully traversed.

Claims 7-13 depend from amended claim 1, which has not been rejected in view of the combination of Wong, Salem and Mantovani. Given that amended claim 1 is patentable for the reasons provided above regarding the rejection in view of Wong and Salem, claims 7-13 are allowable due to the allowability of amended claim 1.

Conclusion

Early notification of allowability is respectfully requested. If there are any remaining issues which the Examiner believes may be resolved in an interview, the Examiner is respectfully invited to contact the undersigned attorney.

Respectfully submitted,

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